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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,909	09/30/2003	George Duncan Pearson	1021-005US02	2080
51871	7590	09/02/2008	EXAMINER	
Shumaker & Sieffert, P.A. 1625 Radio Drive, Suite 300 Woodbury, MN 55125				SAINDON, WILLIAM V
ART UNIT		PAPER NUMBER		
3623				
		MAIL DATE		DELIVERY MODE
		09/02/2008		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/675,909	PEARSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	William V. Saindon	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 May 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 and 12-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/23/2008</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

1. The following NON FINAL Office Action is in response to Applicant's submission received May 16, 2008. Claims 1-10 and 12-14, have been amended. Claim 11 has been canceled. Claim 21 has been added. Therefore, claims 1-10 and 12-21 are pending.

### ***Response to Amendment***

2. Applicant's amendments are acknowledged.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-10 and 12-21 have been considered but are moot in view of the new grounds of rejection. The rejection has been updated to address the newly claimed elements.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 7-10, 12, and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The steps recited do not qualify as a statutory process. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying

subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The claims clearly do not transform underlying subject matter. Further, the claims are not tied to another statutory class because the steps recited do not require a particular apparatus (e.g. a particular computer). Therefore, the claims are non-statutory.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 4-6, 10, 12, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, the claim recites that "the administration console reconciles the contribution data that was received prior to the check-out." However, there is no sufficient written description of this reconciliation process. At ¶ 52, the specification merely states that reconciliation is done; no steps or description of a methodology used

is given. The Examiner can find no further support for this limitation. No person of ordinary skill would know the Applicant was in possession of a method for reconciling the data after check-out because no description relating to the matter is provided.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 4-6, 10, 12, 13, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The scope of the "reconciling" is not clear. Applicant has provided no example methodology by which the reconciling is to occur, nor what the result is. The Examiner will not guess as to the intended meaning of this language because such a guess would be merely speculative in nature.

Specifically to claim 21, it is unclear how the application server can prevent users from saving or reviewing data associated with an individual node yet still not "taking the model offline," as claimed in claim 1. If the server prevents a user from reviewing data associated with a node, then that node will no longer function, destroying the limitation of the parent claim that the modifications do not take the model offline. Therefore, no meaning can be ascribed to language that undoes the parent claim.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. **Claims 1-10 and 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elkin et al. (U.S. 2007/0179828) in view of Examiner's Official Notice.**

**Claim 1:** Elkin discloses a system comprising:

an application server to execute an enterprise planning session for a set of enterprise contributors in accordance with an enterprise model, wherein the enterprise model defines hierarchically arranged nodes and associates the enterprise contributors with the nodes (see ¶¶ 13, 15, 40, Fig. 3, noting an enterprise model application allows users to define enterprise models in a hierarchical fashion); and

an administration console that supports node-level modification of the enterprise planning model without preventing execution of the enterprise planning session by the application server (see ¶ 13, noting users may edit the enterprise model without affecting current enterprise operations).

But Elkin fails to explicitly disclose, and the Examiner takes Official Notice that it is old and well known to:

Modify individual nodes (Heinl, § 2.2, noting that flexibility by adaption is where a node is modified to include additional paths to other nodes; Halliday at 7, noting that tasks are individual nodes of a workflow and can be edited in a dynamic reconfiguration).

Execute the enterprise planning session in accordance with the model while the modifications are occurring [i.e. dynamic modification/reconfiguration] (Heinl at 80, first column, noting that modifications to the workflow occur in real-time, that is, while the model is still running; Halliday § 2.3 - Flexibility by adaptation: Dynamic Reconfiguration, noting tasks are modified).

That the administration console allows an analyst to check-out individual nodes of the model for editing during execution of the enterprise planning session without taking the model offline (Heinl, Fig. 6, noting the lock / check out policy of one node at a time A or B; § 4.2.3, noting the use of check-in / check-out).

It would have been obvious to a person having ordinary skill in the art at the time of invention to modify the system in Elkin to include the dynamic modification features well known in the art, such as check-out of individual nodes and real-time modification.

These well-known features are a known improvement to workflow systems like Elkin, and would provide the predictable result of allowing the system to be flexible as situations change.

**Claim 2:** Elkin discloses the system of claim 1, wherein the administration console receives updated model information from the analyst, and updates the enterprise planning model based on the updated model information (see ¶¶ 146 and 196, noting an updated process model may be overlaid on the existing process model in real-time).

Elkin fails to explicitly disclose that the nodes are checked-out. However, as shown in claim 1, node check-out is an old and well-known concept. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to specify that the updates to the model in Elkin are based on the nodes checked-out for updates, for the purpose of allowing changes to an existing model.

**Claim 3:** Elkin discloses the system of claim 2, wherein the administration console modifies business logic software modules in response to the updated model information (see ¶¶ 196-198).

Elkin fails to explicitly disclose that the nodes are checked-out. However, as shown in claim 1, node check-out is an old and well-known concept. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to specify that the updates to the model in Elkin are based on the nodes checked-out for updates, for the purpose of allowing changes to an existing model.

**Claims 4-6 and 21:** These claims do not specifically point out and distinctly claim the subject matter that the Applicant regards as his invention. The Examiner will not give speculative prior art rejections.

**Claims 7-10 and 12-20:** The method and computer-readable medium claims 7-10 and 12-20 recite limitations similar to the system claims 1-6 already rejected above. Therefore, claims 7-10 and 12-20 are rejected on the same basis as claims 1-6 above.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Clarence Ellis & Grzegorz Rozenberg, "Dynamic Change Within Workflow Systems," COOCS 95 (ACM 1995), disclose workflow systems handling dynamic change.

W.M.P. Van der Aalst, "Generic Workflow Models: How to Handle Dynamic Change and Capture Management Information?," Fourth IECIS International Conference on Cooperative Information Systems 115 (1999), discloses a workflow model that handles dynamic change.

J.J. Halliday et al., "Flexible Workflow Management in the OPENflow system," in 4th International Enterprise Distributed Object Computing Conference (EDOC 2001), disclose a particular workflow management system, OPENflow.

Petra Heinl et al., "A Comprehensive Approach to Flexibility in Workflow Management Systems," SIGSOFT Software Engineering Notes, vol. 24, no. 2, p. 78 (March 1999), provide a detailed analysis of dynamic workflow.

Frank Maurer et al., "Web-Enabled Dynamic Workflow Technologies," IEEE Internet Computing 65 (May/June 2000), discloses a workflow product that handles what happens after a change in a node occurs.

Nguyen (US 2003/0135384) discloses a workflow process that is dynamically updated.

Ledford et al. (US 2003/0171947) disclose a business process management method with dynamic workflow modification.

Berkery et al. (US 2004/0205074) disclose a workflow method with check-out editing system.

Lo et al. (US 6,212,534) disclose a document check-out system that prevents other users from access to the checked out document.

Eldridge et al. (US 7,272,815) disclose a system where task nodes are checked out.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Saindon whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623